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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,181	08/30/2001	Peter Heffernan	5181-80002	8590

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EXAMINER

BAROT, BHARAT

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/943,181	HEFFERNAN ET AL.	
	Examiner	Art Unit	
	Bharat N Barot	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/5/02 & 10/10/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

2. Claims 1-4, 11-16, and 24 are objected to because of the following informalities: Claims 1-4, 11-16, and 24 contain "a said", which are typographical errors. These are representative examples. Applicants should review all pending claims for similar problems. Appropriate corrections are required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
4. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following terms lack proper antecedent basis:

- said/the data carrier___claims 1-7, 11, and 21;
- said/the network___claims 1-2, 11-13, 21, and 24; and
- said/the reader___claim 7 .

These are representative examples. Applicants should review all pending claims for similar problems. Other dependent claim, which is not specifically cited above are also rejected because of the deficiencies of its respective parent claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGauley et al (U.S. Patent No. 5,899,998) in view of Eichinger et al (U.S. Patent No. 6,370,374).

7. As to claim 1, McGauley et al disclose a processing unit (point of service station) connectable to a communications network (abstract; and figures 1 and 6 reference no. 110), the processing unit having a data carrier reader operable to read data from a portable data carrier (figures 1 and 6 reference no. 100) (column 5 lines 51-58; and column 6 lines 1-5 and 11-35), the processing unit being operable on being powered up to check for the presence of the portable data carrier, and when the portable data carrier is present, to use the data from the portable data carrier for communicating via the communications network (figure 6; column 11 lines 55-59; column 12 lines 62-67; and column 13 lines 18-33).

However, McGauley et al do not disclose that the processing unit operable to read a network identity from a portable data carrier to use the network identity from the portable data carrier for communicating via the communications network.

Eichinger et al disclose a processing unit (mobile radio telephone terminal) connectable to a communications network (abstract; and figure 1), the processing unit operable to read a network identity (access numbers/string) from a portable data carrier (SIM card) to use the network identity from the portable data carrier for communicating via the communications network (figures 1-3; column 2 line 50 to column 3 line 9; column 3 lines 24-35; column 4 lines 23-31; and column 6 line 35 to column 7 line 55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Eichinger et al stated above in the system of McGauley et al for using the network identity read from the portable data carrier for communicating via the communications network because it would have configured to provided the network services easily available for the users of the system and lowered probability of an erroneous input.

8. As to claims 2-4, McGauley et al disclose that the processing unit is operable, on detecting the absence of the portable data carrier, to prevent access to the communications network, to record a fault condition, and to terminate its power-up sequence (figure 6; column 11 lines 20-64; and column 12 line 62 to column 13 line 17).

9. As to claims 5-6, McGauley et al disclose that the portable data carrier is a memory card or smart card and the data carrier reader is a memory card reader or smart card reader (abstract; column 5 lines 51-58; column 6 lines 1-5 and 11-35; and column 11 lines 20-25 and 42-54).

10. As to claim 7, McGauley et al disclose that the data carrier reader includes a securing mechanism to hinder removal of the portable data carrier when present in the data carrier reader (figure 6; column 11 line 55 to column 12 line 14; and column 12 line 62 to column 13 line 17).

11. As to claims 8-10, Eichinger et al disclose that the processing unit is replace-ably mount-able in a carrier, wherein the carrier is a rack and the processing unit is a rack mount-able computer server (figure 1; column 3 lines 6-9; and column 6 lines 35-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Eichinger et al stated above in the system of McGauley et al because it would have configured to provided the network services easily available for the users of the system and also provided a reliable system by increasing scalability and flexibility of the system.

12. As to claim 11, it is also rejected for the same reasons set forth to rejecting claim 1 above. Additionally, McGauley et al disclose that a computer server system comprising a communications network for providing data communications to devices connected to the communications network (figures 1 and 6 reference no. 150).

13. As to claims 12-15, they are also rejected for the same reasons set forth to rejecting claims 1-4 above, since claims 12-15 are merely a method of operation for the apparatus defined in the claims 1-4.

14. As to claim 16, Eichinger et al disclose that a user manually providing the data carrier carrying the network identity to the data carrier reader to prior to powering up the processing unit (figures 1-3; column 6 line 60 to column 7 line 24; and column 7 lines 37-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Eichinger et al stated above in the system of McGauley et al because it would have configured to provided the network services easily available for the users of the system and also provided a reliable system by increasing scalability and flexibility of the system.

15. As to claims 17-20, they are also rejected for the same reasons set forth to rejecting claims 5-10 above, since claims 17-20 are merely a method of operation for the apparatus defined in the claims 5-10.

16. As to claims 21-23, they are also rejected for the same reasons set forth to rejecting claims 1 and 5-6 above.

17. As to claim 24, it is also rejected for the same reasons set forth to rejecting claims 1 and 12 above, since claim 24 is merely a program product for the apparatus defined in the claim 1 and for the method of operation defined in the claim 12.

Additional References

18. The examiner as of general interest cites the following references.

- a. Parker et al, U.S. Patent No. 6,374,110.
- b. Aoki et al, U.S. Patent No. 5,691,525.

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Contact Information

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bharat Barot whose telephone number is (571) 272-3979. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, can be reached at (571) 272-3978.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Patent Examiner Bharat Barot

Art Unit 2155

December 17, 2004


BHARAT BAROT
PRIMARY EXAMINER